

REMARKS

Entry of the present Amendment and reconsideration of the claims is requested.

Status of the Claims

Claims 16, 17 and 19 have been amended and the amendments do not add new matter.

Claims 21-28 have been added.

Claims 1- 28 are pending in the application.

New claims 21-28 do not add new matter.

Support for the amendments to claims 17 and 19 can be found in the Specification, e.g, page 2, line 23 to page 3, line 3; page 4, lines 4-11; and page 7, lines 11-15. Support for new claims 21-28 is found in claims 1-20 as originally presented and in the Specification on page 7, lines 16-21; page 8, line 23 to page 9, line 5; page 9, lines 20-29; and page 11, line 16 to page 12, line 3.

Rejections Under 35 U.S.C. § 102

The Lowell Reference

Claims 1-5, 9-11, 13, 14, and 17-20 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,012,086 to Lowell. The Examiner states that Lowell discloses every feature of the claimed invention, including generating a handle, transmitting the handle to a second location through a network and rendering a media object at a second location. Applicant respectfully traverses the rejection.

Applicant disagrees with the Examiner's interpretation of Lowell and submits that Lowell does not disclose all of the elements of the independent claims (claims 1, 9, 13, 17 and 19).

Regarding the step of "generating a handle at a first location," Lowell does not provide a handle. Lowell's invention requires a user to enter data into the separate fields of a database that is resident on the user's computer or on a server. The user's computer then uses the information in the database to execute a series of steps. The handle of the present invention is a self-contained "content reference" (Specification page 4, line 19); it is "a small relatively secure data structure identifying particular content, and may contain various additional information about the content referenced." Specification, page 5, lines 15-17. The handle is a data object that can be transmitted instead of the content so the user can access the handle and then access the content directly at the content's original source. *See*, Specification, page 4, lines 4-20 and Figure 1.

Lowell's method does not provide this data structure, and does not "identify" particular content. Lowell notes that "first field 404 is the source URL field. In this field the user types the URL or Internet address for the web site of the server which is providing the data to be recorded." Lowell, column 6, lines 23-26. Lowell's URL is a non-specific content location on the web and contains no information about the content to be referenced. Lowell further requires a "recording" of the key strokes necessary to download the content at a particular time. *See*, Lowell, column 6, lines 45-57. The location alone of a piece of content does not identify it, nor do the steps to retrieve the content add any more to the content's "identity". This is akin to retrieving a book according to instructions for finding it, e.g.: "At 2 p.m., take the fifth book from the fourth shelf of the third row in the mystery section of the bookstore located at 33rd

Street and 3rd Avenue." Such instructions identify location, not content, and the location, of course, may change and may change without warning.

Regarding the step of "transmitting the handle from the first location to a second location through the network," Lowell is a timed macro player and thus does not transmit a handle according to the claims.

Regarding the above, Lowell's invention functions as follows (*See*, Lowell, column 7, line 49 to column 8, line 15 and Figure 6):

1) A user enters a URL, a series of key strokes that the user would have to perform if the user was actually accessing the website designated by the URL and a start and stop time (steps 602 and 604). The time is not transmitted to a second user location, it remains local to the user's computer or sent to the server.

2) At the designated start time, the user's computer activates the browser and enters the URL into the browser (step 606).

3) The predefined macro is executed (step 606). The macro is a predefined stored series of keystrokes, entered at the user's computer, and later transmitted as keystrokes to the website. The "keystroke information" is sent in sequence as a stream; it is not transmitted to a second location as a handle.

Thus, Lowell merely automates the keystroke activity of a user at a predetermined time. Lowell does not transmit information or a handle as required in the claimed invention.

Applicant also submits that Lowell does not disclose transmitting the handle to a second user location (claims 1, 9, 13, 17, and 19); "rendering the identified media object at the second location" as stated in claims 1, 9 and 13 or "displaying the media object at the second location" as stated in claims 17 and 19. Lowell does not contemplate a second user location as defined in the claims. Lowell's invention centers around the user's computer, which is only a first location. Applicant submits that Lowell's invention is, in essence, an Internet VCR. Like all VCRs, it can only "render" at one location. The user of Lowell's invention enters information to record the Internet event on the user's computer. Thus, the user's computer can be considered the first location. Lowell's invention then accesses the Internet using the predefined commands and transmits the data back to the user's computer, which is still the first location. The Internet site of Lowell that a user wishes to access is not the "second location" as defined in the claims. Nothing is rendered for the user at the Internet site and thus, nothing is rendered at a "second location" as claimed. All of the information from the Internet site is returned to the user's computer and is either stored on the user's hard drive, or the user can designate an external recording device, i.e. a DAT or VCR. See, Lowell, column 9, lines 11-34. Lowell does not teach, or even suggest, that the data the user records can be transmitted to anyone other than the user.

Applicant respectfully submits that Lowell does not disclose either the "handle", the "transmitting" step, or the "rendering" step, nor does Lowell have the claimed "second location." Lowell thus cannot anticipate the claims of the present invention. Additionally, claims 2-5, 10, 11, 14, 18 and 20 all depend from the independent claims and recite over the prior art based on their dependency from the independent claims and their own recitation.

The HTML 4.0 Reference

Claims 1 and 4-8 stand rejected under 35 U.S.C. § 102(b) as anticipated by the HTML 4.0 Specification (hereinafter "HTML 4.0"). The Examiner contends that HTML 4.0 discloses every element of the claimed invention. Applicant respectfully traverses the rejection.

Applicant respectfully submits that HTML 4.0 is not an enabling reference and that the Examiner is improperly using hindsight to reject the claims. HTML 4.0 is only a listing of numerous commands which may be used in infinite combinations by programmers, writing software in the HyperText Markup Language. HTML 4.0 does not teach one of ordinary skill in the art how to perform the steps of the present invention. HTML 4.0 teaches over 400 pages of commands. The reference does not provide a disclosure of how to select and combine commands to produce the invention, nor any motivation to do so. For example, the Examiner cites Section 2.2 as disclosing the "generating" and "transmitting" steps. Section 2.2 is entitled "What is HTML?" and its only subsection is entitled "A brief history of HTML". Section 2.2 discloses in very broad terms that HTML permits a user to:

Publish online documents with headings, text, tables, lists, photos, etc. Retrieve online information via hypertext links, at the click of a button. Design forms for conducting transactions with remote services, for use in searching for information, making reservations, ordering products, etc. Include spread-sheets, video clips, sound clips, and other applications directly in their documents.

The above statement does not enable one of ordinary skill in the art to "generate" or "transmit" a handle as stated in the claims, nor to manipulate a handle or to render content at a second location, as claimed.

The Examiner also sites Section 13.3.1 as disclosing the "rendering" step. Section 13.3.1 provides the "Rules for rendering objects" and the programming syntax and variables to render an object

in HTML, but provides no teaching or motivation on how to use these rules, alone or in combination with other commands, to provide the manner, timing, location, etc. for rendering content at a second user location according to a handle, as claimed. There is no disclosure of how to combine this command with any others, including the general disclosure in Section 2.2, to provide the present invention. There is also no motivation to do so, nor any expectation of arriving at the claimed invention. The two cited sections of the reference are separated by about 150 pages of descriptions for commands to perform numerous actions. Without a description of how to use the commands to create the claimed features, and that one of ordinary skill should pick these particular commands from hundreds, HTML 4.0 does not enable one of ordinary skill to create the presently claimed invention.

Applicant respectfully submits that the Examiner has, in mechanical terms, cited a parts list and is improperly using hindsight to "assemble" the invention where the reference provides nothing but a catalogue of disparate parts. That some or all of the invention could be implemented in the HTML programming language does not make the commands of that language into a written description or enabling disclosure that in any way provides or would even remotely point to the claimed invention. Thus, HTML 4.0 does not anticipate the claims of the present invention.

The Bayrakeri Reference

Claims 1, 4, 6, 9, and 11-15 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,185,602 to Bayrakeri. The Examiner states that Bayrakeri discloses every element of the claimed invention.

Applicant disagrees that Bayrakeri discloses all of the features of the claimed invention. Nevertheless, Applicant respectfully traverses the rejection in this Response by submitting a Declaration under 37 C.F.R. § 1.131(along with documentary evidence in form of Exhibits 1 and 2). The Declaration, signed by Applicant, states that Applicant had completed the invention as claimed in the present application prior to the earliest filing date of Bayrakeri. Exhibits 1 and 2 of the Declaration clearly describe every element of the claims in detail.

With respect to the subject matter of claims 1, 4, and portions of the subject matter of claims 6, 9, 11-16, and new claims 21-27, Exhibit 1 discloses a method for transmitting media information over a network by generating a handle at a first user location where the handle identifies a media object; transmitting the handle from the first location to a second user location through the network; and rendering the identified media object at the second user location in accordance with the handle by displaying video content and producing audio content.

For example, the Exhibit 1 discloses that to "synchronize Online activities ... [e.g. w]eb links, email, Instant Messaging ... will be through the Edit Decision Lists (EDL's)" and "EDLs will only consist of references to media contents, and not embed the contents themselves," pages 10 and 36. The EDL "can be sent to other users." Exhibit 1, page 36. Thus, the EDL is an embodiment of a "handle" as recited in the claims.

Further, Exhibit 1, in general, describes the functionality of the Universal Media Player (UMP) wherein the UMP renders media objects in accordance with the EDL. The UMP will be able to view, play or execute multiple types of content. Supported types will be audio data in PAC/ACC and DTS formats, video in AVI, QuickTime & MPEG1 formats,

JPEG, BMP & GIF pictures, text in HTML, RTF, and ASCII formats and Windows 95 compatible executable & object files. UMP will also be able to read and generate Edit Decision Lists (EDLs). EDLs will allow authors and users to describe simultaneous or sequential played sequences of the supported types of content and, the UMP will be able to play & record these sequences.

Exhibit 1, pages 9-10, and see, Diagram Two, page 11. These early descriptions provide the methods and structures of the presently claimed invention.

The subject matter of claims 6, 12 and 15 is further described in Exhibits 1 and 2. An object-id; a sku-id; a distributor-id; a retailer-id; a channel-id; a renderer-id; a carrier-id; a disk-id; a user-id; an absolute-time-id; a temporal-location-id; and a temporal-state-id are supported by Exhibit 1. Exhibit 1, on pages 50-52, discloses that the EDL contains a number of identifiers, including time information for synchronization and the temporal information regarding the media. The figure on page 51 of Exhibit 1 illustrates some of the other information stored in the EDL, including the identification of specific content, for example, "Play SONG 1". Exhibit 2 further discloses how content can be identified. Specifically, "to uniquely identify an object, this object will be assigned an Object ID or OID" and this OID is readable by the EDL. Exhibit 2, pages 9-10. Exhibit 2, on page 10, also describes using "SKU's as OID's", "Channel Identifiers" including a "Retailer ID, or RID" and a "Distributor ID or DID".

Additional support for claims 9 and 11 regarding the feature of identifying a value-chain participant is supported by the disclosure described above because an OID

will have attributes ... [and t]he current set of properties fall into two categories, creator and owner. The creator set will include the Artist(s), Writer(s), Musicians(s), producer(S) [sic] ... and provide the information for PRO and other mandated rights management functions. The Owner properties will define the owner of the copyright in both the song, Publisher(s), and the recording, Music Company(s) as well as the distribution channel (s) if appropriate.

Exhibit 2, page 10.

Additional disclosure supporting the identification of a value-chain participant is that a "Reference Function maintains information about all the OID's, CID's and RID's, their relationships (associations) and selected relevant information (e.g., the expiration date, a brief description of offers and content objects, etc.)." Exhibit 2, page 22.

Additionally, claim 11 and a feature of claim 14 requires the transmission of the handle from the second user to the server and receiving from the server the media object identified by the handle. Exhibit 1 discloses that the EDL can be sent to anyone and contains all the information required to purchase rights to the content. The EDL can "contain all of the information regarding how to purchase the rights to non-owned content so that the recipient of the EDL is able to enjoy the same experience as the creator of the EDL." Exhibit 1, page 34. Thus, once the user purchases the content, the user then receives a media object from a server. See, Exhibit 1, page 34.

Claims 13-15 and new claims 23-25, are further supported by the Exhibits and Declaration. Claims 13 and 23 recite that the rendering of the media object at the first location is synchronized with the rendering of the media object at the second location. Exhibit 2 discloses the synchronization of renderings on e.g., pages 32, 33, 50, and 51 and Exhibit 2 on page 33. "A key function of the operation of the EDL is the notion of synchronization. The players will then begin at the pre determined time, giving a sync play." Exhibit 2, page 50.

Further, claims 4 and 6; 11-12; and 14-15 also all depend from claims 1, 9 and 13, respectively, and thus contain all of its limitations per 35 U.S.C. § 112, fourth paragraph. Additionally,

MPEP § 2131 states that a "claim is anticipated only if each and every element as set forth in the claim is found... in a single prior art reference." Thus, if the elements of claims 1, 9, and 13 are antedated, the reference is not prior art, and all of the claims have elements not in the prior art, all of the independent and dependent claims are allowable.

Thus, Bayrakeri has been removed as a reference, the above rejection is rendered moot and Applicant respectfully requests that the 35 U.S.C. § 102(e) rejection based on Bayrakeri be withdrawn.

The Koppolu Reference

Claims 17 and 19 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication No. US 2002/0103824 to Koppolu et al. (hereinafter "Koppolu"). The Examiner states that Koppolu discloses all of the elements of the claimed invention. Applicant respectfully states that claims 17 and 19 have been amended and Koppolu does not anticipate the new features.

Koppolu does not expressly or inherently teach the "handle" or "transmitting the handle from the first user location to a second user location" as recited in claims 17 and 19. Koppolu discloses creating a unified browsing environment within a single user's applications. *See*, Koppolu, page 2, paragraphs 0012 to 0016. Koppolu integrates all of the features and applications of a single user's computer to provide:

a object-oriented framework or architecture 300 for unified hyperlink navigation between any documents, objects and applications. In particular, this unified hyperlink navigation is not limited to just HTML documents of the World-Wide Web, or to hyperlinking within a single application such as a web browser.

Koppolu, page 30, paragraph 0439.

Koppolu does not teach or suggest a handle as defined in the claims. Koppolu discloses "hyperlink navigation (e.g. to allow navigation from the application to a hyperlink target)." Koppolu, page 31, paragraph 453. Koppolu further states that "[h]yperlink navigation involves a transition (also known as a "jump") from one document, object, or application ... to another document, object, or application." Koppolu, page 30, paragraph 448. Koppolu's hyperlink is a non-specific content locator. As stated above in reference to Lowell, the location of a piece of content does not "identify" the content.

The handle of the present invention is a self-contained "content reference" (Specification page 4, line 19); it is "a small relatively secure data structure identifying particular content, and may contain various additional information about the content referenced." Specification, page 5, lines 15-17. The handle is a data object that can be transmitted instead of the content so the user can access the handle and then access the content directly at the content's original source. *See*, Specification, page 4, lines 4-20 and Figure 1. Thus, Koppolu's hyperlink is not a "handle", as recited in the claims.

Applicant also submits that Koppolu does not transmit a "handle" between two user locations. Koppolu teaches integrating hyperlink navigation into all applications present on a single user's computer. Koppolu's hyperlinks are not transmitted to a second user location. At best, Koppolu teaches only one user location. This interpretation is supported by the Examiner's statement that "handles are embedded in web pages which are transmitted from the first location, a server, to the second location, a client." Office Action dated January 3, 2003, page 8, paragraph 31, emphasis added. A server is not a user location. This is further supported in claim 19, which recites a first user location, a second user

location and a server.

Furthermore, Koppolu discloses "more complex hyperlink navigation features, such as navigation to a sub-location within a document or object, or cut and paste as well as drag and drop operations." Koppolu, page 31, paragraph 453. Navigating to sub-locations in a document as well as cut and paste operations are all features to be performed at a single location. Thus, Koppolu does not teach or suggest a second user location.

Koppolu does not teach or disclose the "handle" or "transmitting the handle" of the present claims and cannot anticipate the presently claimed invention. Thus, Applicant respectfully requests that the above rejection be withdrawn.

Rejections Under 35 U.S.C. § 103

Lowell and Stefik References

Claims 2 and 10 stand rejected under 35 U.S.C. § 103(a) as obvious over Lowell, in view of U.S. Patent No. 5,629,980 to Stefik et al. (hereinafter "Stefik"). The Examiner states that the combination of Lowell and Stefik teaches or suggests all of the features of the claimed invention. Particularly, the Examiner states that Stefik teaches obtaining an identifier for the media object, obtaining an identifier for each participant of a value-chain and combining the identifiers to form a handle.

Applicant respectfully traverses the above rejection. Claims 2 and 10 depend from claims 1 and 9, respectively, and Lowell does not disclose every element of claims 1 and 9. The arguments above, as they pertain to Lowell, are relevant in traversing the present rejection.

Additionally, Stefik teaches away from forming a handle. The handle, as stated in the claims, is not transmitted with the content. *See*, Specification, page 5, lines 11-14. In contrast, Stefik states that a "key feature of ... [his] invention is that usage rights are permanently "attached" to the digital work. Copies made of a digital work will also have usage rights attached. Thus, the usage rights and any associated fees assigned by a creator and subsequent distributor will always remain with a digital work."

Stefik, column 6, lines 51-56. Stefik's usage rights are never transmitted without the digital work because "attached usage rights ... enable distinct advantages over prior systems ... [Previously] once a work has been read, computational control over that copy is gone." Stefik, column 6, lines 62-66. One of ordinary skill in the art is not motivated to take Stefik's identifiers and transmit them separately from the content contrary to the stated purpose of Stefik's invention.

Further, Stefik does not fill the gaps between Lowell and the claims of the present invention. As above, Stefik does not disclose or suggest a "handle" and thus does not disclose "transmitting a handle" as recited in claims 1 and 9.

Thus, Lowell and Stefik, alone or in combination, do not teach or suggest every element of the claimed invention. Applicant respectfully requests that the above rejection be withdrawn.

HTML 4.0 and Stefik

Claim 2 stands rejected under 35 U.S.C. § 103(a) as obvious over HTML 4.0, in view of Stefik. The Examiner states that the combination of HTML 4.0 and Stefik teaches or suggests all of the features of the claimed invention. Applicant respectfully traverses the above rejection.

Claim 2 depends from claim 1 and HTML 4.0 does not disclose every element of claim 1 of the invention. The arguments above, as they pertain to HTML 4.0, are relevant in traversing the present rejection. Additionally, Stefik both teaches away from and does not fill the gaps between HTML 4.0 and the claims of the present invention. One of ordinary skill in the art is not motivated to combine Stefik with the teachings of HTML 4.0 nor does Stefik disclose a "handle" or "transmitting a handle". The arguments above, as they pertain to Stefik, are relevant in traversing the present rejection. Thus, HTML 4.0 and Stefik, alone or in combination, do not teach or suggest every element of the claimed invention. Applicant respectfully requests that the above rejection be withdrawn.

Bayrakeri and Stefik

Claims 2 and 10 stand rejected under 35 U.S.C. § 103(a) as obvious over Bayrakeri, in view of Stefik. The Examiner states that the combination of Bayrakeri and Stefik teaches or suggests all of the features of the claimed invention. Applicant respectfully traverses the above rejection.

Claims 2 and 10 depend from claims 1 and 9, respectively. Applicant states that neither Bayrakeri nor Stefik discloses every element of the invention. Nevertheless, Applicant respectfully traverses the rejection in this Response by submitting a Declaration under 37 C.F.R. § 1.131 in regards to Bayrakeri. Thus, the arguments above and the Declaration under § 1.131, as they pertain to Bayrakeri, are relevant in traversing the present rejection. Additionally, Stefik both teaches away from and does not fill the gaps between Bayrakeri and the claims of the present invention. One of ordinary skill in the art is not motivated to combine Stefik with the teachings of Bayrakeri nor does Stefik disclose a "handle" or

"transmitting a handle". The arguments above, as they pertain to Stefik, are relevant in traversing the present rejection. Thus, Bayrakeri and Stefik, alone or in combination, do not teach or suggest every element of the claimed invention. Applicant respectfully requests that the above rejection be withdrawn.

Bayrakeri and Borella

Claim 16 stands rejected under 35 U.S.C. § 103(a) as obvious over Bayrakeri, in view of U.S. Patent No. 6,182,125 to Borella et al. (hereinafter "Borella"). The Examiner states that the combination of Bayrakeri and Borella teaches or suggests all of the features of the claimed invention. Applicant respectfully traverses the above rejection.

Applicant respectfully submits that claim 16 has been amended to depend from claim 13 and Bayrakeri does not disclose every element of claim 13 of the invention. Nevertheless, Applicant respectfully traverses the rejection in this Response by submitting a Declaration under 37 C.F.R. § 1.131 in regards to Bayrakeri. Thus, the arguments above and the Declaration under § 1.131, as they pertain to Bayrakeri, are relevant in traversing the present rejection.

Additionally, Applicant states that Borella does not disclose every element of the invention and does not fill the gaps between Bayrakeri and the claims of the present invention. Nevertheless, Applicant respectfully traverses the rejection in this Response by submitting a Declaration under 37 C.F.R. § 1.131 (along with documentary evidence in form of Exhibits 1 and 2). The Declaration, signed by Applicant, states that Applicant completed the invention as claimed in the present application prior to the earliest filing date of Borella.

The elements of claim 16 that the Examiner states are disclosed by Borella are supported by the Declaration and Exhibit 1. The 'time calculation' element of claim 16 is further disclosed in Exhibit 1 on pages 36 and 50-51, which discloses computing a transport time and then rendering a media object incremented by the transport time. Thus, since the elements of claim 16 are antedated, Borella is not prior art. Thus, Applicant respectfully requests that the above rejection be withdrawn.

Koppolu and Chiles

Claims 18 and 20 stand rejected under 35 U.S.C. § 103(a) as obvious over Koppolu, in view of U.S. Patent No. 6,167,567 to Chiles et al. (hereinafter "Chiles"). The Examiner states that the combination of Koppolu and Chiles teaches or suggests all of the features of the claimed invention. The Examiner states that Chiles teaches updating software previously downloaded from a software source. Applicant respectfully traverses the above rejection.

Claims 18 and 20 depend from claims 17 and 19, respectively, and that Koppolu does not disclose every element of claims 17 and 19 of the invention. The arguments above, as they pertain to Koppolu, are relevant in traversing the present rejection.

Additionally, Applicant submits that Chiles does not disclose every element of the invention and does not fill the gaps between Koppolu and the claims of the present invention. Chiles does not expressly or inherently teach the "handle" or "transmitting the handle from the first user location to a second user location." Chiles only discloses automatically updating software and handles are not associated with the updates. Additionally, Chiles does not teach or suggest a second user location. Chiles states that his

"invention not only permits substantially any client-resident software to be automatically and properly updated, through a networked server and without substantially any user intervention." Chiles, column 8, lines 23-26. Chiles only teaches a first user location and a server. As stated above, a server is not a user location. Thus, Applicant respectfully requests that the above rejection be withdrawn.

Antedating the References

Applicant respectfully submits a Declaration under 37 C.F.R. § 1.131 (along with documentary evidence in form of Exhibits 1 and 2). The Declaration, signed by Applicant, states that Applicant completed the invention, as claimed, prior to the earliest filing date of Bayrakeri and Borella.

The requirements for an affidavit for "swearing back" of a reference are outlined in 37 C.F.R. § 1.131, in which part (b) states:

[t]he showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.

Additionally, the courts have held, and as relied upon in MPEP § 715.07, that:

there must be some stage of an invention when it must be presumed as a matter of law that the inventor has reduced his invention to practice; and that stage is presumed to have been reached when he has done all that he is required to do to obtain a valid patent, namely, when he has filed a complete and allowable application.

Automatic Weighing Machine Co. v. Pneumatic Scale Corp., 166 F. 288, 297 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909). See also, MPEP §§ 715.02 and 715.07.

Applicant submits that the character and weight of the facts shown in the Declaration are sufficient to establish conception of the invention prior to the effective date of Bayrakeri and Borella. Additionally, the invention was diligently reduced to practice at least as early as the filing of the priority document for this application.

The requirement to establish the dates sufficient to show conception and a diligent reduction to practice are as stated in MPEP §§ 715.07 and 715.07(a). MPEP § 715.07 outlines the requirement to establish dates to prove conception and states:

If the dates of the exhibits have been removed or blocked off, the matter of the dates can be taken care of in the body of the oath or declaration. When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date.

Applicant has redacted all dates from Exhibit 1 and 2, but states in the body of the Declaration, at paragraph 2, that:

Prior to June 29, 1998, the effective date of the Bayrakeri reference (U.S. Patent No. 6,185,602) and prior to the effective date of the Borella et al. reference (U.S. Patent No. 6,182,125 - filed October 13, 1998) (hereinafter "Borella"), I had completed my invention as described and claimed in the subject application in this country, a NAFTA country, or a WTO member country. My invention was conceived in full, and due diligence was used to reduce it to practice, for example by filing this patent application. As evidence that my work antedates Bayrakeri, I refer to Exhibit 1, the document entitled Preliminary UMP Viewer Application Functional Specification & Software Requirements, Version 2.85 (hereinafter "UMP Viewer Spec") and Exhibit 2, the document entitled Preliminary UMP Viewer Application Functional Specification & Software Requirements - Section Three Infrastructure to Support Deployment of the UMP Player, Version 0.607 (hereinafter "Infrastructure Spec"). Both the UMP Viewer Spec and the Infrastructure Spec are in-house specifications. Dates and certain other proprietary disclosures appearing in this document have been redacted. I declare that these documents (Exhibits 1 and 2) were

created before June 29, 1998.

Additionally, the Declaration contains facts showing the conception of the invention prior to the references and commensurate with the scope and extent of the invention as claimed. The Declaration contains explicit references to Exhibits 1 and 2 and shows direct support for each combination of the independent claims. Exhibits 1 and 2 contain detailed descriptions of each major element of the claims and how they cooperate to produce the invention. Applicant submits that the Declaration is ample evidence that the present inventor conceived the invention in full before the reference, followed by the diligent application for a patent.

MPEP § 715.07(a) outlines the requirement to prove diligence in reducing an invention to practice and states:

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, ... applicant must show evidence of facts establishing diligence. ... Under 37 C.F.R. 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference ... and ends with the date of a reduction to practice, either actual or constructive.

Given the above, Applicant must show diligence from June 29, 1998 (the effective date of Bayrakeri, which is earlier than the filing date of Borella) to the filling of the provisional patent application upon which this application is based (the constructive reduction to practice). The provisional patent application (serial no. 60/116,555), was filed January 21, 1999, just seven months after the effective date of the prior art. Applicant submits that a seven month period of further work on the invention and preparation of a patent application is per se within the limits of reasonable diligence.

During this period, Applicant was in communication with his attorneys regarding the preparation and filing of the parent provisional application. Information about the invention was submitted

to the attorneys and the application was drafted, reviewed, revised, and filed with the USPTO. Applicant submits that there is sufficient evidence that during the seven months from June 29, 1998 until January 21, 1999, he was working continuously on the invention and preparation of a patent application.

Applicant submits that the Declaration and facts therein are sufficient and proper under 37 C.F.R. § 1.131(b) to show that the invention was conceived prior to the effective date of Bayrakeri, which is earlier than the filing date of Borella, and was diligently reduced to practice by further diligent work toward reduction to practice, ending with the filing of the above provisional application.

Applicant respectfully submits that the present invention was conceived prior to the priority dates of Bayrakeri and Borella and thus the two references have been rendered moot.

CONCLUSION

Therefore, in view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,



Louis L. DelJudece
Reg. No. 47,522
Attorney for Applicant(s)

DARBY & DARBY, P.C.
Post Office Box 5257
New York, NY 10150-5257
Phone (212) 527-7700